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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/659,375      09/08/00      TAKAHASHI

T      1539.1002 RE

021171  
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MM91/1031

EXAMINER

HENRY, I

ART UNIT

PAPER NUMBER

2872

DATE MAILED:

10/31/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/659,375		TAKAHASHI, TOMOWAKI	
	<b>Examiner</b>		<b>Art Unit</b>	
Jon W. Henry		2872		

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>10</u> . | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 2872

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 18, 2001 has been entered.

### ***Reissue Applications***

2. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See *In re Weiler*, 790 F.2d 1581, 229 USPQ 673 (Fed. Cir. 1986).

Applicant asserts in item no. 7 of the declaration filed September 18, 2001 (and item no. 7 of the declaration filed November 21, 2000), an error drafting claims 1 and 10 of the patent unduly narrowly, which error has been corrected in at least claim 27. However, claim 27, as well as all the other newly presented independent claims, are also narrower than any patent claims by at least the recitation of "dioptric" and none of the claims newly presented in reissue are purely narrower than any of the patent claims. That is, all newly presented claims include separate features from all of the patent claims. Additionally, no allowable linking claim has been presented to indicate the inventions claimed in the patent have unity of invention with the inventions claimed in the claims newly presented in reissue. In fact, it appears the patentability of the claims newly presented in reissue and the patent claims, if any, is related to the separate features of the inventions. The fact the common subject matter of the patent claims and claims

Art Unit: 2872

newly presented in reissue do not appear to relate to an unclaimed allowable linking claim directed to the newly claimed subject matter minus the recitation of “dioptric ” is emphasized by reference to the Fig. 7 embodiment of Suenaga et al that may anticipate or at least make obvious such subject matter newly claimed in reissue “but for” the recitation of “dioptric.” Therefore, it appears the claims newly presented in reissue relate to subject matter “entirely distinct” from anything earlier claimed or attempted or intended to be claimed. See *In re Weiler*, 790 F.2d 1581, \_\_\_, 229 USPQ 673, 675 (Fed. Cir. 1986). Additionally, the original patent claims have not been changed at all, and therefore it appears any statutory error would have to relate to the claims newly presented in reissue.

Applicant’s statements in his declaration, including item no. 7, do assert the inventions newly claimed in reissue are not directed to “entirely distinct” inventions and therefore *Weiler* is not controlling case law. In particular, applicant asserts newly presented claim 58 is an allowable linking claim for inventions claimed in the original patent and now claimed in this reissue application. However, newly presented claim 58 is not allowable as set out in the “rejection” that follows. Clearly applicant cannot circumvent the prohibition of claiming inventions in reissue “entirely distinct” from those of the patent for which reissue is sought, as set forth in *Weiler*, merely by presenting a nonallowable linking claim in reissue. Otherwise, the holding of *Weiler* would have no force to limit the inventions for which reissue examination may be made to inventions that are not “entirely distinct” inventions from those of the patent because a broad nonallowable claim linking any two inventions disclosed in the original application from which a patent was obtained may always be presented in a reissue application. Therefore, it appears applicants’ declaration is defective for failing to establish statutory error under 35 USC 251 in

Art Unit: 2872

accordance with *Weiler*. See *In re Weiler*, 790 F.2d 1581, \_\_\_, 229 USPQ 673, 677-678 (Fed. Cir. 1986).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 58 is “rejected” under 35 U.S.C. 102(b) as being anticipated by Friedman (U.S. Patent No. 4,779,966).

The term “rejected” is enclosed in parentheses because the holding of obviousness over the prior art under 35 U.S.C. 103(a) of the subject matter of claim 58 clarifies that applicant has not established statutory error that would support reissue examination in this application as set out in *Weiler*.

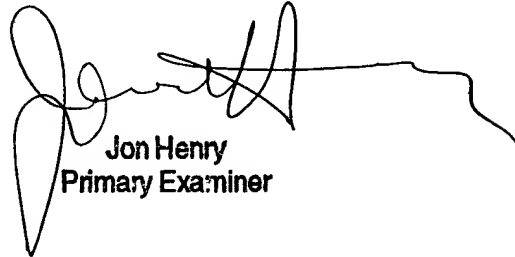
Friedman (-966), the Fig. 4 embodiment, discloses a method for projecting a pattern from a reticle onto a substrate with all of the features recited in claim 58. See Table II with regard to lens surfaces 3-6 defining one or two negative lens subgroups together, lens surfaces 8-11 or 12 and 13 defining a positive lens subgroup, and lens surfaces 14-17 defining one or two negative lens subgroups together.

***Conclusion***

5. For the reasons set forth previously, claims 1-58 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251.

Art Unit: 2872

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon W. Henry whose telephone number is (703) 305-6106. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou, can be reached on (703) 308-1687. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.



Jon Henry  
Primary Examiner